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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,522	12/03/2003	Yuichiro Murayama	Q78604	4994

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EXAMINER

RESAN, STEVAN A

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,522

Applicant(s)

MURAYAMA ET AL.

Examiner

Stevan A. Resan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim*s 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inaba et al US 6074724 in view of Nishimatsu US 4596747 for the reasons of record.

The limitations for newly added claims 14-19 may be found in Inaba et al Col 13 line 40; Col 26 line 47-64; Col 23 line 24; Col 44 lines 6-41 and Nishimatsu Col 9 line 62.

3. Applicant's arguments filed 6 April 2005 have been fully considered but they are not persuasive.

Applicants traverse the examiner's rejection under 35 USC 103 based upon Inaba and Nishimatsu on the basis that one of ordinary skill in the art would not have been motivated to combine the teachings of the references i.e add Nishimatsu's primer coating layer to Inaba's structure since Inaba's second embodiment already accomplishes a relatively smooth surface on the magnetic layer by the use of the undercoat layer.

Applicants argue that adding an additional primer coating layer "for the same purpose" would not be motivation to add the layer.

However, as the examiner pointed out in the last office action the motivation would be to improve adhesion. Inaba et al at Col 14 lines 33-36 suggests this use and Nishimatsu et al teach that use of their layer will improve adhesion (Col 2 line 4). Motivation to combine for one reason is motivation to combine for all reasons.

Applicants also advance arguments on the inclusion of carbon black in the magnetic layer and lower layer in some of the examples. However Inaba et al are not limited to the examples. Furthermore carbon black may be used for a number of reasons (e.g. to modify viscosity of the coating solutions) not merely for imparting antistatic properties to a layer.

Applicants final arguments then center upon the examples and comparison examples of the specification.

Applicants argue that the examples show unexpected improvement over the comparative examples. However the examples are not commensurate in scope with the subject matter being claimed. In re Kulling, 897 F2d 1147, 1149, 14 USPQ 2d 1056, 1058 (Fed Cir 1990); In re Grasselli, 713 F 2d 731, 743, 218 USPQ 769, 777 (Fed Cir. 1983); In re Soni, 54 F 3d 746, 34 USPQ 2d 1684 (Fed Cir 1995).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (571) 272-1513. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney who can be reached on (571) 272-1284

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The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.



STEVAN A. RESAN
PRIMARY EXAMINER